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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/830,860 | 06/11/2001 | Tore Danielssen | E-1024 | 5304 |

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| EXAMINER | |
|---|---|
| LEE, RIP A | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1713 | 6 |

DATE MAILED: 10/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 09/830,860 | Applicant(s) DANIELSSEN ET AL. | |
|---|---|---|---|
| | Examiner Rip A. Lee | Art Unit 1713 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) 1-7 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-7 is/are rejected.

7)☒ Claim(s) 3 and 5 is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

### *Claim Objections*

1. Claim 3 is objected to because of the following informalities: In line 6 of the claim, change "to" with "into." Also, the resin composition described by the claim is not a compound by any means, nor can it be formed into a compound by normal chemical means. Appropriate correction of the term is required.

2. Claim 5 is objected to because of the following informalities: An apparent typographical error has been made. The claim should depend from claim 3, not claim 2. Correction is required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 3, and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The exemplary term "particularly" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2,210,882 to Clarke *et al.*

Clarke *et al.* discloses an epoxy resin composition characterized by particulate filler of wide particle size distribution comprising the following fractions: (*i*) 2-35 % in the sub-micron range and/or (*ii*) 30-80 % in the 1-50 μ range and (*iii*) 5-40 % in the 50-250 μ range. The submicron particulate filler is present as particles substantially in the 0.1-1.0 μ range, an example being microsilica (page 6). The 1-50 μ fraction of the filler is quartz powder, fly ash, or talc, and the 50-250 μ fraction of the filler is sand or quartz grit (page 7). The reference does not show in Examples 1-5 use of microsilica and talc in combination, however, it would have been

obvious to one having ordinary skill in the art to arrive at the present claims because such an embodiment is clearly disclosed. From the brief summary of the invention above, one would have found it obvious to use microsilica in combination with talc, and one would have expected such a combination to work because their use is taught Clarke *et al.*

While the Clarke *et al.* patent does not make reference to polyolefins, polyvinylchloride, and polyamide, these three recitations are considered exemplary. As stated in the rejection under 35 U.S.C. 112, second paragraph (*supra*), the exemplary term "particularly" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. That epoxy resins are thermoplastic renders the present claims obvious in view of the prior art.

Regarding the claimed weight ratio between talc and microsilica of 15:1 to 1:15, Clarke *et al.* teach the use of 2-35 % sub-micron range filler, *i.e.* microsilica, and (*ii*) 30-80 % filler in the 1-50 μ range such as talc. Since it is obvious that the weight ratio of filler in a composition comprising 30 % talc and 35 % microsilica is roughly 1:1, and since this amount is disclosed in the invention, it is obvious that such an embodiment would satisfy the claimed 15:1 to 1:15 (and also the 6:1 to 1:5) weight ratio.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (703)306-0094. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)746-7064. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

DAVID W. WU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

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September 25, 2002